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OFFICE OF PETITIONS

In re Application of

Knud Klingler

Application No. 10/760,658

Filed: January 19, 2004

Attorney Docket No. 41587.012502(346)

: DECISION ON PETITIONS

: UNDER 37 CFR 1.78(a)(3)

: AND 37 CFR 1.55(c)

This is a decision on the petition, filed August 29, 2006, which, for the reasons stated below, is being treated under the provisions of both 37 CFR 1.78(a)(3) and 37 CFR 1.55(c) to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to a prior-filed international PCT application, and under 35 U.S.C. § 119(a)-(d) for the benefit of priority to a prior-filed foreign application.

The petitions are **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) and (iii) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The petition seeks acceptance of a late claim for priority to international Application No. PCT/EP99/03825, filed June 2, 1999, as a foreign application, as well as to foreign German

Application No. 19825225, filed June 5, 1998. A claim for domestic priority was made in the transmittal letter on filing to Application No. 09/729,538, filed December 4, 2000. As the PCT application to which petitioner is now seeking to claim benefit of priority was filed on June 2, 1999, benefit as a foreign application would be improper since the filing date of intermediate Application No. 09/729,538 is more than 12 months from the filing date of the PCT application. As such, this application is not entitled to a claim for benefit of priority to the PCT application as a foreign application under the provisions of 35 U.S.C. § 119(a)-(d) through intermediate Application No. 09/729,538. However, pursuant to 35 U.S.C. § 365(c), a regular national application filed under 35 U.S.C. § 111(a) and 37 CFR 1.53(b) may claim benefit of the filing date of an international application which designates the United States. Accordingly, this petition has been treated as one requesting acceptance of a late claim for priority under the provisions of 37 CFR 1.78(a)(3) for benefit of domestic priority to the above-noted PCT application under 35 U.S.C. §§ 120 and 365(c).

It is further noted that the amendment improperly states that prior-filed Application No. 09/729,538 is a national phase of PCT/EP99/03825. Inspection of relevant USPTO records reveals that prior-filed parent Application No. 09/729,538 was not filed under the provisions of 35 U.S.C. § 371 but, rather, under the provisions of 35 U.S.C. § 1.111(a) and 37 CFR 1.53(b). Accordingly, there is clearly no basis for the assertion that 09/729,538 can be the national phase of any application filed under a multinational treaty. If petitioner should persist in the assertion that 09/729,538 is a national phase of any treaty filed application, then he is requested to provide clear and convincing documentary evidence to support his assertion. In the absence of such clear and convincing evidence, prior-filed Application No. 09/729,538 did not enter the national phase in the United States and as such may only be viewed as a "bypass" application described in MPEP 1895. It follows that, since petitioner clearly wishes to obtain benefit of the 09/729,538, application, the PCT international filing date, and the German national application filing, 09/729,538 can best be properly described as a U.S. continuing application under 35 U.S.C. §§ 120 and 365(c) of PCT/EP99/03825. However, under this circumstance, in order to obtain benefit of the German national filing via the PCT application, and since there is no evidence that application ever entered the national stage in the U.S., a certified copy of the German national application is required. See MPEP 1895.01:

A claim for foreign priority under 35 U.S.C. 119 (a)-(d) must be made in the continuing application in order to obtain the benefit of the filing date of the prior filed foreign application. This is true regardless of whether such a claim was made in the parent international application. A foreign priority claim is proper in the continuing application if the foreign application was filed within 12 months prior to the filing of the continuing application or within 12 months prior to the international filing date of the parent international application. In addition, the required claim must be made within the time period set forth in 37 CFR 1.55 (a)(1). This time period is not extendable. See MPEP § 201.14. A certified copy of any foreign priority document must be provided by the applicant unless the

parent international application has entered the national stage under 35 U.S.C. 371 and the national stage application contains a photocopy of the priority document from the International Bureau. See MPEP § 1893.03(c). In such case, the applicant, in the continuing application, may state that the priority document is contained in the national stage application

Since inspection of 09/729,538 (now a U.S. patent) fails to reveal that such a priority benefit was claimed, correction of the priority claim of the prior patent must be effectuated before the corrected claim may be made herein.

As to the benefit claim under 37 CFR 1.78(a)(3):

The rule at 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application or international application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application and international filing date and indicating the **relationship** of the applications. *Note also* MPEP 1895.01, which states:

To obtain benefit under 35 U.S.C. 120 and 365(c) of a prior international application designating the U.S., the continuing application must:

- (A) include a specific reference to the prior international application (either in the application data sheet (37 CFR 1.76) or in the first sentence of the specification),
- (B) be copending with the prior international application, and
- (C) have at least one inventor in common with the prior international application.

The **relationship** between the applications is whether the application is a continuation, continuation-in-part, or division. An example of an appropriate first sentence of the specification is, for example, "this is a continuation of International Application PCT/EP04/00000." The reference to the prior filed applications must be included in either the first sentence of the specification following the title or in an application data sheet pursuant to the provisions of 37 CFR 1.76. The petition is not accompanied by the reference required by 37 CFR 1.78(a)(2)(i) and (iii).

Further, it is noted that prior-filed Application No. 09/729,538 does not make a reference to prior-filed International Application No. PCT/EP99/03825. Where an application claims a benefit under 35 U.S.C. § 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. *See Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); *Sticker Indus. Supply*

Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP § 201.11. Petitioner may have relief by filing a petition in prior-filed parent Application No. 09/729,538 under 37 CFR 1.78(a)(3) (and fee of \$1,370) to accept an unintentionally delayed claim for priority under 35 U.S.C. § 120 and 365(c) to International Application No. PCT/EP99/03825. As prior-filed Application No. 09/729,538 is now a patent, the petition must also be accompanied by a certificate of correction and fee therefor.

For the reasons set out above, the petition to accept an unintentionally delayed claim for domestic priority under 37 CFR 1.78(a)(3) to International Application No. PCT/EP99/03825 cannot be granted.

As to the benefit claim under 37 CFR 1.55(c):

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6));
- (3) the surcharge as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Director may require additional information where there is a question whether the delay was unintentional); and
- (5) the application claiming benefit of priority to a prior-filed foreign application must be filed within 12 months of the filing date of the foreign application.

The petition under 37 CFR 1.55(c) is **DISMISSED**.

The petition fails to comply with item (2) above. In this regard, the application data sheet fails to state the correct filing date of the foreign German application (Application No. 19825225). More specifically, the application data sheet states that the filing date of the German application is June 2, 1999, rather than the correct filing date of June 5, 1998. Note MPEP 201.14.

In view of the above, compliance with 37 CFR 1.63(c)(2) or 37 CFR 1.76(b)(6) must be satisfied if applicant desires to claim priority to the German national application noted in the petition.

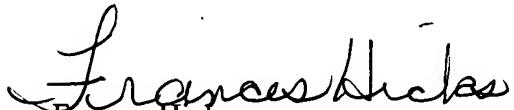
If petitioner seeks reconsideration of this decision, the renewed petition should be entitled "Renewed Petition under 37 CFR 1.78(a)(3) and 1.55(c)" and contain a proper statement of unintentional delay as to the delayed filing of the claim for benefit to the international and foreign applications. The renewed petition should be addressed as follows:

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By fax: (571) 273-8300
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.



Frances Hicks
Petitions Examiner
Office of Petitions